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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,608	02/14/2001	Milton Smith	0879-0299P	9767

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/782,608

Applicant(s)

SMITH, MILTON

Examiner

Raymond J. Bayerl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005; 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 - 23, 41 - 47 is/are allowed.
- 6) ☒ Claim(s) 24 - 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 7 – 10, 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 7, it is not clear what antecedent applicant intends for “The one or more computer-readable media of claim 1”, when parent claim 1 is instead directed to “A computer-implemented method”. Please note a similar problem with claim 9.

Also in claim 7, after the 21 January 2005 amendment, “said input module” has been left without clear antecedent, since now all that remains is a step of “converting the received images” in parent claim 1.

As per claim 12, please note that the most recent amendment renders uncertain “including the image”, since “the received images” are now recited.

3. Claims 24 - 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. (“Frey”; US #6,369,908 B1) and Yager et al. (“Yager”; US #5,983,236).

As per claim 24’s “kiosk”, “inputting one or more images” is at least to be found in Frey’s PHOTO KIOSK, which similarly discloses that a cpu is used to capture an electronic image, so that the user can selectively add to the electronic image and save the electronic file on a removable electronic storage device (Abstract).

Responsive to “one or more service requests”, the captured image in Frey is sent to the cpu (col 3, lines 43 – 67), which displays the captured image onto the monitor 13, thereby allowing the user to review the captured image. Since coded instructions are

invariably expressible using characters, the “service requests” in the Frey KIOSK can be interpreted as forming a “text order file”, specifying in Frey “one or more types of image processing to be performed on each of the one or more images”.

Frey’s **explicit** disclosure appears to be that of a single-source image acquisition arrangement, via a digitizing camera at the KIOSK location, and not one that involves “sending the one or more images and the order file to a second processing device”. However, such dual-device processing is suggested by the multiple-terminal arrangement of Yager, who in PROVIDING A MULTIMEDIA PRESENTATION, works with combinations of audio, video, still images, and text which are represented by binary data files (Abstract). Yager is described at col 3, lines 7 – 25, as building a data file from component data, where a file type identifier is associated with the synchronized output (see also col 2, lines 42 – 65), this being forwarded to an external recipient after having been sourced from pre-existing image data.

It would therefore have been obvious to a person having ordinary skill in the art at the time of applicant’s invention to separate (as per Yager) the processing of image sourcing and instruction gathering from image processing, “to satisfy the corresponding one or more service requests” handled by Frey, so as to increase system flexibility and siting options. The motivation to use an approach like Yager’s server set-up resides in Frey, where the destination for the “images” is already placed upon a separate server, when the customer wishes e-mailed copies or when the resultant storage medium is opened. Yager, superimposed upon this, will treat the Frey “kiosk” as a server, and

then perform the "processing" on the "second processing device" so as to generate the final MULTIMEDIA PRESENTATION.

At the "second processing device", then, of the Frey/Yager combination, "outputting of the one or more images" will take place (claim 25). In receiving "service requests" from the Frey "kiosk" for such typical "image processing" as would include "cropping" (claim 35), "attributes associated with the specified output device" (claim 26) will necessarily be transmitted over a "communicative link" (claim 40) as a "preference" (claim 36), as is identically seen when Frey specifies output modes for the images captured. These will include the "output image file format" (claim 27) and "output media" (claim 28), as instructed from the higher-order Frey device. Included are at least "a digital storage device", to satisfy claim 29, and "output" "on the specified medium" (claim 30).

At the point that the "customer" directs a Yager-enhanced Frey "kiosk", "customer information" includes at least one of "price, and method of payment" (claim 31), or the transaction cannot proceed. Frey, as noted above, allows specification of "an address" (claim 32) of "a digital storage device" (claim 34) using a "file directory" (see also claim 38), and a principal finished "medium" in such an environment as photo-imaging is "a print medium" involving at least "border information" (claim 33). In this scenario, "print sizes" are also specified (claim 37). In the alternative, the "processing device" components can be located together, as in claim 39; indeed, this is a feature of a "kiosk" such as Frey's, in creating immediate added value at a given site.

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4. Applicant's arguments entered 22 February 2005 have been fully considered but they are not persuasive, as regard the claims that continue to be rejected as indicated above.

Applicant argues (remarks, page 24) that "the proposed combination of Frey and Yager would not teach or suggest crating a text order file". "Instead, according to the Frey/Yager combination, the server would send *synchronization information* with the components, to indicate how the video clip should be processed" and "Yager only teaches that the synchronization information contains data indicating points of temporal correlation between the various video clip components." However, the invariable potential that all coded instructions have for being textually represented allows for an interpretation of claim 24 to be made in which the "order file" can be seen as "text". Also, it is Frey, not Yager, who principally teaches the input of an "order file", so as to specify image processing operations at the KIOSK. These would then obviously direct the operations of Yager, as input to the "second processing device".


5. Claims 1 – 23, 41 – 47 are allowable over the prior art of record. The amendments and remarks concerning these claims, as found in the 21 January 2005 response entered with the 22 February 2005 request for RCE, are persuasive.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

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7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



**RAYMOND J. BAYERL**  
**PRIMARY EXAMINER**  
**ART UNIT 2173**

31 March 2005